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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,413	11/24/2003	Peter J. Kight	23952-0055	8055
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SUTHERLAND II			EXAMINER	
SUTHERLAND, ASBILL & BRENNAN, LLC			MILEF, ELDA G	
999 PEACHTREE STREET				
ATLANTA, GA 30309			ART UNIT	PAPER NUMBER
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			03/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,413

Applicant(s)

KIGHT ET AL.

Examiner

Elda Milef

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)
Paper No(s)/Mail Date 2/4/2004; 6/24/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because "provuder" should be --provider-- in line 6. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-20 are indefinite because the use of the words "initiating" and "initiate" render the scope of the claims unclear. For example, in claim 1, the role of the service provider is indefinite.

Claim 3 and 12 recite the limitation "(iv) directing another type crediting". The meaning of this limitation is unclear and indefinite.

Claim 4 and 13 recite "(i)directing one of the ACH and the other type crediting..."), the meaning of "the other type crediting" is indefinite.

Note that in light of the above 35 U.S.C. 112 rejection, for examination purposes, the Examiner is interpreting "initiating" as processing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 6, 7, 8, 10, 11, 14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent (US Patent No. 6,839,687) in view of Marlin (Marlin, Steven. "Microsoft, First Data Alliance Seen to Boost Bill-Pay; Banks' Role Still Unclear"; Bank Systems & Technology; Sep 1997; 34, 9; pg. 8.)

Re claim 1,6,7,10,16: Dent disclose a method, system and integrated billing and payment network comprising:

transmitting, from the service provider to a payor via the communications network, bill information representing a first bill of a first payee, but not a second bill of a second payee, for the payor;

receiving, at the service provider via the communications network, a first payment instruction to pay the first bill based on the transmitted bill information;

initiating, at the service provider, payment of the first bill to the first payee based on the received first payment instruction;

-see cols. 3-6

Dent do not specifically disclose receiving, at the service provider via the communications network, a second payment instruction to pay the second bill; initiating, at the service provider, payment of the second bill to the second payee based upon the second payment instruction. Marlin however, teaches ("Today, you can go to the CheckFree Web site...to not only pay your presented bill but also your pay-any bills."). It would have been obvious to one having ordinary skill in the art to include in the consumer-based bill management and payment system of Dent the ability to provide a service provider with a second payment instruction to pay any bill as taught by Marlin since the claimed invention is merely a combination of old

elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Re claim 2,11: Dent disclose a method and system including a cashflow analyzer that assesses how paying the bills will impact the consumer's cashflow. -see cols. 6-10, in particular col. 10 lines 9-19. The cashflow analyzer determines if alternative financing is needed to cover the negative balances in the consumer's accounts and suggests financing options to the consumer such as charging a certain bill amount to a credit card. It is obvious that the cashflow analyzer is perceiving a risk associated with non-payment of a bill by determining a potential default or missed payment and presenting alternative financing to the consumer.

Re claim 8,14: Dent disclose a method and system wherein the transmitted bill information further represents a third bill of a third payee for the payor, and the received first payment instruction is to pay the first and third bills based on transmitted bill information based on the received first payment instruction.-see col. 2 lines 56-60.

4. Claims 3-5, 12, 13, 17, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent in view of Marlin in further view of Shipley (Shipley, Chris. "I Threw Away My Checkbook." (CheckFree's Electronic Bill-paying Service); PC-Computing, v3, n11, p112(7); Nov, 1990.

Re claims 3, 12, 17: Dent disclose a method and system wherein the debit type selected from a group including ACH debiting of a deposit account associated with the payor ("unlike existing direct debit arrangements, the consumer is in direct control of the amount to be paid and the payment date as well as which account they wish to use to pay the bill...")-see col. 3 lines 59-62; if the selected debit type is the ACH debiting, the payment is initiated by (i) directing ACH crediting of a deposit account associated with the one payee with funds from the deposit account associated with the payor.-see col. 2 lines 56-60.

Although Dent discloses the cashflow analyzer determining a negative balance in a consumer's account due to payment of a bill, and the cashflow analyzer suggesting to the consumer alternative financing options, and the consumer being able to choose which account to use to pay bills, Dent do not

specifically disclose choosing to pay a bill using a negotiable instrument. It is obvious that if Dent provides the consumer with the ability to choose which account to debit in order to pay a bill, a check drawn on a consumer's checking account would be an option. Furthermore, it is notoriously old and well known in the art of bill paying that a paper check is used to make payments as evidenced by Shipley p. 5 para. 7-6.

It would have been obvious to one having ordinary skill in the art to include in the consumer-based bill management and payment system of Dent the ability to choose paying a biller via a check as taught by Shipley since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Re claim 4,13,18: Dent disclose a method, system and integrated billing and payment network wherein:

the selected debit type is the ACH debiting in col. 3 lines 59-62. Dent do not specifically disclose the payment is initiated by (ii) preparation of the negotiable instrument, payable to the one payee, drawn on the deposit account associated with the service provider, and by directing an ACH crediting of the deposit account associated with the service

provider of the ACH debited funds from the deposit account associated with the payor. Shipley however, teaches ("CheckFree writes a check on its own bank account, sends it to the vendor and charges your bank account electronically three days later.")-see p.5 para. 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dent and Marlin to specifically include that the service provider issue a check to a vendor from its own bank account and credit the service providers account with funds debited from the account of the payor as taught by Shipley in order to make payments to non-electronic vendors.

Re claim 5: Dent disclose wherein the other type of crediting of the deposit account associated with the one payee is RPS crediting.-see col. 10 lines 9-19.

Claim 19 has similar limitations found in claims 4 and 5 in combination and is therefore rejecting using the same art and rationale.

5. Claims 9,15,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent in view of Marlin in further view of Lewis (Lewis, Peter H. "Personal Computers; Managing Your Money". New York Times, Late Edition- Final ED. col. 5. p.8. August 29, 1989).

Re claim 9, 15, 20: Dent discloses the claimed method, system, and integrated billing and payment network supra. Dent and Marlin do not specifically disclose receiving at the service provider a third payment instruction of the payor, not associated with a bill, to pay a third payee and initiating payment. Lewis however, teaches ("You say you want to use Checkfree to pay American Express, but also to issue an allowance check to Junior? Again, no problem. If funds cannot be transferred point to point electronically, Checkfree will use its high-speed laser printer to produce and mail a check to anyone you designate, anywhere, on any date your specify.")-see p.2 para. 6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dent and Marlin to specifically include a third payment instruction of a payor not associated with a bill to pay a third payee as taught by Lewis in order to pay anyone using an electronic payment method.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 8,978,780 (Watson) -cited for its reference to determining a payment risk factor and debiting alternate

payment sources if the initial consumer account does not have sufficient funds to cover the amount of the bill. -see Fig. 4C. 2(652 & 655) and related text; cols. 5-6; 12-14; col. 16 lines 18-29; col. 17 line 53 to col. 20..

U.S. PG. Pub. 2007/0136169 (Dilip et al.)-cited for its reference to automatically analysis of debt and asset accounts and the system advising moving funds.

Tangwall, Doug. "The On-line Billing & Payment Race." Credit Union Executive Journal; Nov/Dec 1999, 39, p. 6.-cited for its reference to electronic bill payment including bill presentment allowing billers to send electronic invoices to customers directly or through a third party.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday -Thursday 8:30 am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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3692

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